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10/783,477	02/20/2004	Joseph J. Kubler	14364US17	7468
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EXAMINER				
MOUTAOUAKIL, MOUNIR				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,477

Applicant(s)

KUBLER ET AL.

Examiner

MOUNIR MOUTAOUKIL

Art Unit

2419

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

The amendment filed on 08-18-2008 has been considered and entered.

Claims 1-21 are canceled.

Claims 22-93 are pending in this application.

Claims 22-93 are rejected as discussed below.

Claim Objections

1. Claims 22-93 are objected to because of the following informalities: It has been held that the recitation that an element is "capable of" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Appropriate correction is required.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the processor in communication between conventional telephone switching network and packet network

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 32-41, 50-57, 68-77, and 86-93 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must

(1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. The claims do not qualify as statutory process because they are directed to an abstract idea and recite purely mental steps.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 22-93 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
7. Regarding claim 22, the examiner could not find support in the specification for "the at least one processor capable of establishing communication signals representative of voice between the packet network and the conventional telephone switching network link, if call status indicating establishment of a connection is received" and "the at least one processor capable of refraining from establishing communication of signals representative of voice between the packet network and the conventional telephone switching network link, if call status indicating establishment of

a connection is not received". If the applicant can find supports in the specification the examiner will withdraw the rejection. Similar issues occur in claims 32, 42, 50, 58, 68, 78, and 86.

Claims 23-31, 33-41, 43-49, 51-57, 59-67, 69-77, and 79-86 are rejected because they depend on rejected claims.

Claim Rejections - 35 USC § 103

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 22, 23, 27, 31, 33, 32, 37, 41, 42, 45, 49, 50, 53, 57, 58, 59, 61, 63, 67, 68, 69, 71, 73, 77, 78, 81, 86 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy III et al (US 5,734,981) in view of Focsaneanu et al (US 5,610,910). Hereinafter referred to as Kennedy and Focsaneanu.

12. Regarding claims 22, 32, 42, 50, 58, 68, 78, and 86. A system supporting voice communication via a packet network, the system comprising: at least one processor capable of receiving (fig.1, element 18), via a conventional telephone switching network link (the link between 38 and 18, also col.6, lines 6-14, platform 18 receives a call for mobile unit 18 from unit 36) a message requesting setup of a voice call (col.6, lines 6-14, platform 18 receives a call for mobile unit 18 from unit 36), the message comprising a destination address (col.6, lines 6-14, platform 18 receives a call for mobile unit 18 from unit 36, the received request includes a phone number); the at least one processor capable of sending, via a different communication network (20) (fig.1, 18 initiates a voice call through network 20), signals based upon the destination address requesting setup of the voice call (the call is initiated based on the request received from 36 through the conventional network); the at least one processor capable of receiving, via the conventional telephone switching network link, signals representing call status (col.6, lines 49-54, platform 18 provides all the features known by central office or mobile telecommunication switching office, which include call status); the at least one processor capable of establishing communication of signals

representative of voice between the different communication network and the conventional telephone switching network link, if call status indicating establishment of a connection is received (the purpose of platform 18 is to connect 12 to any of the other phone devices); and the at least one processor capable of refraining from establishing communication of signals representative of voice between the packet network and the conventional telephone switching network link, if call status indicating establishment of a connection is not received (col.6, lines 49-54, platform 18 provides all the features known by central office or mobile telecommunication switching office, which include tear down and busy signals that indicate that the intended destination can not establish a connection due to an off-hook situation or similar).

Kennedy discloses all the limitations of the claimed invention with exception of establishing a connection between a different communication network device and a conventional network device, where the call is initiated by the different communication network device. However, at the time of the invention, it would have been obvious to an ordinary person of skill in the art to provide Kennedy with receiving call establishment message from different communication network device and directed to a conventional network device for the purpose of providing efficient services to customers within different network providers and architectures.

Kennedy discloses all the limitations of the claimed invention with the exception that the different network is a packet network. However, Focsaneanu, from the same field of endeavor discloses a method of communication between a conventional network and a packet network (see figure 3, Focsaneanu discloses an access module which

contains a database of users information such as a translation table for converting telephone numbers into a packet network addresses). Moreover, Focsaneanu also discloses the same features, such as establishing a call and notifying users from different ends of a busy condition, if status information indicating a busy condition is received (col.11, lines 60-65). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the network of Focsaneanu and Kennedy for the purpose of extending network range and allowing more diverse network and capabilities to be offered.

Regarding claim 23, 33, 59, and 69. Kennedy in view of Focsaneanu discloses that the destination address comprises one of internet protocol address and a telephone number (Kennedy: see col.6, lines 6-14 and Focsaneanu: see fig.3, and col2, line 58 – col.3, line 15).

Regarding claims 27, 37, 45, and 53, Kennedy in view of Focsaneanu teaches the system wherein the establishing comprises converting information received from the packet network (16, FIG. 1) for transmission via the conventional telephone switching network link (column 12, lines 30-34), and converting information received from the conventional telephone switching network link for transmission via the packet network (Focsaneanu: Fig. 3).

Regarding claims 31, 41, 49, and 57, Kennedy teaches the system of claim 22 wherein establishing voice communication comprises establishing communication of data (column 11, lines 48-56).

Regarding claims 61, and 71, Kennedy teaches that the signals representative of voice comprise modem signals (column 11, lines 54-56).

Regarding claims 63, and 73 Kennedy in view of Focsaneanu teaches where establishing communication of signals representative of voice comprises converting information received from the packet network (16, FIG. 1) for transmission via the conventional telephone switching network link (column 12, lines 30-34), and converting information received from the conventional telephone switching network link for transmission via the packet network (Focsaneanu: Fig. 3).

Regarding claims 67, and 77, Kennedy teaches where establishing communication of signals representative of voice comprises establishing communication of data (column 11, lines 48-56).

Regarding claims 81, and 89, Kennedy and Focsaneanu teach where establishing voice communication between the packet network and the conventional telephone switching network link comprises converting information received from the packet network (16, FIG. 1) for transmission via the conventional telephone switching network link (column 12, lines 30-34), and converting information received from the conventional telephone switching network link for transmission via the packet network (Focsaneanu: Fig. 3).

13. Claims 24, 25, 28, 29, 34, 35, 38, 39, 43, 46, 47, 51, 54, 55, 60, 64, 65, 70, 74, 75, 79, 82, 83, 85, 87, 90, 91 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Focsaneanu and further in view of Henley et al (U.S Patent No. 5,526,353). Hereinafter referred to as Henley.

Regarding claims 24, 34, 43, 51, 60, 70, 79, and 87, Kennedy and Focsaneanu teach the method of claims 22. Kennedy and Focsaneanu, however, fail to explicitly teach the conventional telephone switching network link is an analog communication link. Henley teaches a communication system supporting audio data over a packet-based network consisting a telephone set interface (TSI) that accepts analog signal from the telephone instrument (column 9, lines 51-54). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to modify the teachings of Kennedy and Focsaneanu to make the conventional telephone switching network link an analog communication link as taught by Henley. One is motivated as such to restore the digitized sample and convert it into an analog voltage for reproduction in the telephone instrument (column 10, lines 18-23).

Regarding claims 25 and 35, Kennedy teaches the system of claim 24 wherein the signals representative of voice signals (column 11, lines 54-56).

Regarding claims 28, 38, 46, 54, 64, 74, 82, and 90, Kennedy and Focsaneanu teach the system of claim 27, wherein converting information received from conventional telephone network link (170, FIG. 3) comprises determining voice activity based upon the information received from the conventional telephone switching network link (column 12, lines 55-61). Kennedy and Focsaneanu however, fail to explicitly teach the following:

- reducing the quantity of information transmitted via the packet network, if voice activity is determined to be below a predetermined level; and

- refraining from reducing the quantity of information transmitted via the packet network, if voice activity is determined not to be below the predetermined level.

Henley teaches a system and method for communication of audio data over a packet-based network. It is disclosed the system further comprises a decimation circuit for reducing the transmission of audio data from a designated location of the buffer to shorten the portions of the stream of audio data in the buffer. The circuit addresses the problem when data are read from the buffer slower than they are written to the buffer (column 5, lines 65-67, column 6, lines 1-5). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to modify the teachings of Kennedy and Focsaneanu to have the operational software reduced the quantity of digitized voice information exchanged via the information transmission device by changing the packetization of digitized voice when voice activity on one of the plurality of communication networks falls below a predetermined level. One is motivated as such to ensure the buffer stays close to its predetermined length for efficient realignment of the audio data in the buffer (column 6, lines 11-14).

Regarding claims 29, 39, 47, 55, 65, 75, 83, and 91 Kennedy teaches the method of claim 22. Kennedy and Focsaneanu, however, fail to teach the establishing comprises converting analog representations of voice signals to analog representations of voice signals. Henley teaches a system and method for communication of audio data over a packet-based network. The system according to the embodiment consist of a decompression/analog conversion circuit for converting a stream of digital audio data to

analog audio signal (column 7, lines 27-31) and a digital compression circuit for converting analog audio signal into a stream of digital audio data (column 7, lines 19-21). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to modify the teaching of Kennedy and Focsaneanu to have the establishing comprised converting analog representations of voice signals to analog representations of voice signals taught by Henley et al. One is motivated as such to compensate for jitter in a computer network in order to provide high fidelity transmission of audio data through the network (column 4, lines 66-67).

Regarding claims 85, and 93, Kennedy teaches where establishing voice communication between the packet network and the conventional telephone switching network link comprises establishing communication of data (column 11, lines 48-56).

14. Claims 26, 36, 44, 52, 62, 72, 80, and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Focsaneanu and further in view of Harland (U.S. Patent No. 4,706,242).

Regarding claims 26, 36, 44, 52, 62, 72, 80, and 88, Kennedy and Focsaneanu teach the system of claim 22 wherein the call status represents one of a ringing condition (column 13, lines 9-12), and connection established condition (column 13, lines 6-9). Kennedy and Focsaneanu do not explicitly teach the call status also represents a busy condition. Harland discloses a digital telecommunication system in which a mode of operation entails displaying information such as user's identity and status of the called user's terminal indicating whether the telephony facility is busy (column 5, lines 61-68). Therefore, it would have been obvious to one with ordinary skill

in the art at the time of the invention was made to modify the teachings of Kennedy and Focsaneanu to include the busy condition in the call status as taught by Harland. One is motivated as such to enable the exchange of identity and status information regardless of the existence of prior connections (column 6, lines 13-15).

15. Claims 30, 40, 48, 56, 66, 76, 84, and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Focsaneanu, further in view of Henley and further in view of Sharman (U.S. Patent No. 5,774,854).

Regarding claims 30, 40, 48, 56, 66, 76, 84, and 92, Kennedy in view of Focsaneanu and further in view of Henley teach all the limitations of the claimed invention. Kennedy, Focsaneanu and Henley et al, however, fail to teach the converting of digital representations of voice signals to analog representations of voice signals comprises buffering of digital representations for a period of time to minimize gaps in the resulting analog representation caused by changes in a propagation delay. Sharman teaches a text to speech system operating in real using an acoustic processor and a linguistic processor. Due to the computational time the linguistic processor requires to process data, future requests from the acoustic processor cannot be made. Thus, gaps in the speech output often occur when the acoustic processor requests data from the linguistic processor. Sharman proposes a solution to overcome the gaps in data by adjusting the buffer for minimal of output data so that future requests can be supplied in a timely manner (column 7, lines 39-48). Hence the propagation delay caused by the linguistic processor is a factor affecting the adjustment in the buffer for desired optimal output. Therefore, it would have been obvious to one with ordinary skill

in the art at the time of the invention was made to modify the teachings of Kennedy, Focsaneanu, and Henley et al to have the conversion of digital representations of voice signals to analog representations of voice signals comprises buffering of digital representations for a period of time to minimize gaps in the resulting analog representation caused by changes in a propagation delay as taught by Sharman. One is motivated as such to accurately halt the system based on the output in the event that an interruption occurs (abstract, column 2, lines 34-39).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO_892.

Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

When responding to this office action, applicants are advised to clearly point out the patentable novelty which they think the claims present in view of the state of the art disclosed by the references cited or the objections made. Applicants must also show how the amendments avoid such references or objections. See 37C.F.R 1.111(c). In addition, applicants are advised to provide the examiner with the line numbers and pages numbers in the application and/or references cited to assist examiner in locating the appropriate paragraphs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOUNIR MOUTAOUAKIL whose telephone number is (571)270-1416. The examiner can normally be reached on Monday-Thursday (1pm-4:30pm) eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. M./
Examiner, Art Unit 2419

/H. K./
Supervisory Patent Examiner, Art Unit 2419